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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/973,035

10/10/2001

Bruno Bosoi

P21548

5050

7055 7590 11/21/2003

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EXAMINER

STASHICK, ANTHONY D

ART UNIT

PAPER NUMBER

3728

DATE MAILED: 11/21/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/973,035

Applicant(s)

BORSOI ET AL.

Examiner

Anthony D Stashick

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 19-71 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 57-64 and 71 is/are allowed.
- 6) ☒ Claim(s) 19-21, 30, 36, 37, 46, 47, 65 and 68 is/are rejected.
- 7) ☒ Claim(s) 22-29, 31-35, 38-45, 48-56, 66, 67, 69 and 70 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

*Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on august 20, 2002 has been entered.

*Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 19-21, 36, 46-47, 65 and 68 are rejected under 35 U.S.C. 102(b) as being anticipated by the European reference to Koflach Sportgerate Gessellschaft 0134778 (Koflach '778). Koflach '778 discloses all the limitations of the claims including the following: an inner tightening mechanism 6, 10, 17

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adapted to equip an article of footwear having a flexible or semi-rigid upper 4 mounted on a sole (see Figure 1); a retention band 6 connected to the inner surface of the upper by at least two anchoring points 5 fixed on lateral and medial sides of the upper; at least a portion of the retention band adapted to partially surround a foot of a wearer of the article of footwear in a flexion fold area and extending from the flexion fold area in a direction along a length of the retention band to an area adapted to receive a heel of the foot (see Figures 1 and 2, this portion crosses over the user's instep area); at least one of the anchoring points is positioned substantially above the sole (see 5 in Figures 1 and 3); at least one of the anchoring points 5 is positioned on a central portion of a line connecting a base of the heel to the flexion fold of the foot; a sole (see Figures 1 and 2); an upper 4 mounted to the sole; the upper having a lateral side, a medial side and an inner surface (See Figures 1 and 2); both anchoring points are spaced above the sole (see Figures 1 and 2. anchoring points at same place on each side of the boot).

4. Claims 19, 20, 31, 36, 49-50 are rejected under 35 U.S.C. 102(b) as being anticipated by Salomon 4,160,332. Salomon '332 discloses all the limitations of the claims including the following: an article of footwear (see Figure 1)

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Per examiners  
request

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having a flexible or semi-rigid upper 17; a retention band 8, 8' connected to the inner surface of the upper by at least two anchoring points fixed on lateral and medial sides of the upper (those areas in Figure 1 anchored at 10' and 16'); the retention band partially surrounding a foot of the wearer of the article of footwear in a flexion fold area of the article of footwear (see Figure 1); at least one of the anchoring points is positioned substantially above the sole (see Figure 1); one of the anchoring points including a sliding return 16'; the retention band, which is fixed to the upper at an end to a second of the anchoring points, passes in the sliding return by defining a portion which covers the foot (see Figure 1); the retention band includes at least one distribution plate 1 fixed in the area of the flexion portion beneath the retention band.

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***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 30 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 19 and 36 above in view of Bergeron 5,832,632. The references as applied to claims 19 and 36 above disclose all the limitations of the claims except for the article of footwear having an inner shoe with at least two raising elements fixed on the lateral and medial sides allowing for the retention band to take support on the raising elements. Bergeron '632 teaches that a boot with a retention band can allow for another shoe to be placed within the boot. The shoe placed within the boot can have raising sections (the side edges of the shoe where the laces are located) that allow for the retention band to be supported thereon (see Figure 1). Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to place a shoe within the boot, with raised section on the shoe, as taught by Bergeron '632, to allow for the boot to protect the shoe and allow for tightening of the boot to the shoe without creating extra pressure on the user's foot during use.

***Allowable Subject Matter***

7. Claims 57-64 and 71 are allowed over the prior art of record.

8. Claims 22-29, 31-35, 38-45, 48-56, 66-67 and 69-70 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### *Response to Arguments*

9. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

### *Conclusion*

10. The prior art made of record and relied upon is considered pertinent to applicant's disclosure and is cited on form 892 enclosed herewith.

Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, email [CustomerService3700@uspto.gov](mailto:CustomerService3700@uspto.gov).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony D Stashick whose telephone number is 703-308-3876. The examiner can normally be reached on Monday through Thursday 8:00 am-4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-1148.

Other helpful telephone numbers are listed for applicant's benefit.

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/8335
Fee Increase Questions	(703) 305-5125
Intellectual Property Questions	(703) 305-8217
Petitions/Special Programs	(703) 305-9282
Terminal Disclaimers	(703) 305-8408
Informal Fax for 3728	(703) 308-7769

If the information desired is not provided above, or has been changed, please do not call the examiner (this is the latest information provided to him) but the general information help line below.

Information Help line	1-800-786-9199
Internet PTO-Home Page	<a href="http://www.uspto.gov/">http://www.uspto.gov/</a>



Anthony D Stashick  
Primary Examiner



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November 17, 2003